

REMARKS

PENDING CLAIMS

Claim 1 has been amended to more clearly point out and distinctly claim the invention. Support for this amendment is provided at page 6, paragraph 60 of this invention (US 2002/0153623) as published by USPTO. No new matter has been added by this Amendment. Claim 10 has been amended to include the limitation of claim 21 and claim 21 has been cancelled. After these amendments are entered, 39 claims (claims 1, 3-10, 12-20, 22-34, 48-55) are pending

Rejections under 35 U.S.C. 103 (a)

Claim 1, 3, 9 and 48-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 131 277 in view of Yang et al. 6,042,754 and Martin et al. 5,649,410.

Applicants respectfully submit that a prima facial case of obviousness has not been established, because the primary reference, alone or in combination with secondary references, does not disclose or suggest all of the limitations of the invention as currently claimed. The primary reference (EP 0 131 277) discloses providing the blank with a thickness (i.e. length) of 0.1-1 mm and diameter of 9 mm, thus length/diameter ratio of 0.011-0.11. However, the primary reference does not disclose nor suggest anything about to increase the length/diameter ratio to 0.2 to 5.0 recited in Applicants' amended claim 1. Actually the primary reference prefers to provide a blank with a thickness (i.e. length) of 0.15-0.4 mm and diameter of 9 mm, thus length/diameter ratio of 0.017-0.044 and teaches away from the currently amended claim 1. The secondary references (Yang et al. 6,042,754 and Martin et al. 5,649,410) can not fill the gap left by the primary reference.

For at least the reasons given above, Applicants respectfully submit that the teachings of over EP 0 131 277 in view of Yang et al. 6,042,754 and Martin et al. 5,649,410 fail to disclose or suggest Applicants' invention as defined in the currently amended claimed 1. Claim 3, 9, and 48-54 and claim 55 are directly or indirectly dependent on the currently amended claim1. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 131 277 in view of Yang et al.6,042,754, Martin et al. 5,649,410 and either Ruhlin 5,100,590 or Lee 4,619,793 as applied to claim 4, and further in view of Ingram 5,456,587.

Claim 4 and claims 5-8 are indirectly dependent on the currently amended claim 1. As discussed earlier, the primary reference (EP 0 131 277) does not disclose nor suggest anything about to increase the length/diameter ratio to 0.2 to 5.0 recited in Applicants' amended claim 1. The secondary references (Yang et al. 6,042,754, Martin et al. 5,649,410 and either Ruhlin 5,100,590 or Lee 4,619,793 and Ingram 5,456,587) can not fill the gap left by the primary reference.

For at least the reasons given above, Applicants respectfully submit that the teachings of over EP 0 131 277 in view of Yang et al. 6,042,754, Martin et al. 5,649,410 and either Ruhlin 5,100,590 or Lee 4,619,793, and further in view of Ingram 5,456,587 fail to disclose or suggest Applicants' invention as defined in the claims 5-8. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Claim 10, 12-22, 24, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 131 227 in view of Yang et al. 6,042,754.

Applicants respectfully submit that a prima facial case of obviousness has not been established, because the primary reference, alone or in combination with secondary references, does not disclose or suggest all of the limitations of the invention as currently claimed.

The primary reference (EP 0 131 277) discloses that It is advantageous to produce quality contact lens, if the blank slabs that are placed in the mold before reshaping already have the precise weight of in the mold within approximate +/- 0.5 mg. This is very different from the requirements of the currently amended claim 10. The amended claim 10 discloses depositing the sample in the mold. The mold cavity defines a shape of an ophthalmic lens having a **variable volume** between a first volume and a second volume, the second volume being greater than the first volume. The amended claim discloses the sample volume is between 0.01% and 10% greater than the first volume.

For the conventional injection molding as the primary reference used, the physical cavity is defined by the mold itself, and the material is forced into the cavity. The injection molding process thus utilizes a fixed volume, to form a sample that can have a variable weight. In contrast to this fixed volume mold cavity, compression molding employed by the present invention uses a **variable volume mold cavity**. A certain amount of material is segregated and forced into a specific shape, resulting in a process, which utilizes a **variable volume** to form a

sample that has a fixed weight. [Page 9, paragraph 91 of this invention (US 2002/0153623) as published by USPTO].

The secondary references (Yang et al. 6,042,754) can not fill the gap left by the primary reference because Yang also uses the conventional fixed volume mold. The secondary reference discloses that the quantity of the melt to the die be only slightly more than the quantity needed for making the article. The excess amount of the melt is about 1 to 10% weight of the article but may be larger depending on the polymer used, etc. (Column 11, line 44-49).

For at least the reasons given above, Applicants respectfully submit that the teachings of over EP 0 131 277 in view of Yang et al. 6,042,754 fail to disclose or suggest Applicants' invention as defined in the currently amended claim 10. Claim 12-22, 24, 32 and 33 are directly or indirectly dependent on the currently amended claim 10. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Claim 23, 25-31 and 34 are also directly or indirectly dependent on the currently amended claim 10. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

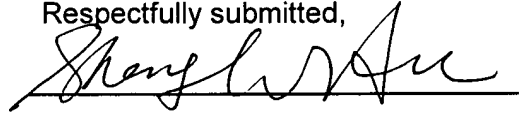
Conclusion

In view of the foregoing amendments, and comments, Applicants submit that rejections set-forth in the Office Action have been overcome, and that all pending claims are now in conditions for allowance.

Should the Examiner believe that a discussion with Applicants' representative would further the prosecution of this application, the Examiner is respectfully invited to contact the undersigned. Please address all correspondence to Robert Gorman, CIBA Vision, Patent Department, 11460 Johns Creek Parkway, Duluth, GA 30097. The Commissioner is hereby authorized to charge any other fees which may be required under 37 C.F.R. §§1.16 and 1.17, or credit any overpayment, to Deposit Account No. 50-2965.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Sheng-Hsin Hu', written over a horizontal line.

Sheng-Hsin Hu

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